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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,615	12/01/2000	Marie Angelopoulos	YOR919960050US3	4765

7590 07/28/2004

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EXAMINER

KOPEC, MARK T

ART UNIT PAPER NUMBER

1751

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/727,615

Applicant(s)

ANGELOPOULOS ET AL.

Examiner

Mark Kopec

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/6/04 has been entered.

The Oath/Declaration of Bruce Firman is noted. In order to change the inventorship of the instant application, a petition under the appropriate section(s) of 37 C.F.R. 1.48 must be filed. See MPEP 201.03.

The terminal disclaimers filed 4/6/04 are entered. The ODP rejections are withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no antecedent basis for the terminology "said solvent".

The prior art rejections over WO 92/22911 in view of either the Handbook of Common Polymers or Kirk-Othmer, MacDiarmid et al (5,484,884) and Epstein et al (4,913,867) are withdrawn in view of applicant's remarks. Specifically, the prior art references does not disclose or fairly suggest the claimed "polycrystalline", "interstitial" or "isotropic" properties, nor are such an inherent certainty.

Claims 1-24 are rejected under 35 U.S.C. 102(e) as anticipated by Angelopoulos et al (5,804,100).

These rejections are maintained for the reasons set forth at pages 10-16 of Paper #5 (Rejection mailed 2/28/03).

Applicant's remarks regarding these rejections are noted.

The examiner notes the reference is to the same assignee and cannot be utilized in a 1039(a) rejection. However, the examiner may be utilized in a 102(e) rejection. Where the prior application (a nonprovisional application) is found to be fatally defective because of insufficient disclosure to support allowable claims, a later-filed application filed as a "continuation-in-part" of the first application to supply the deficiency is not entitled to the benefit of the filing date of the first application. *Hunt Co. v. Mallinckrodt Chemical Works*, 177 F.2d 583, 587, 83 USPQ 277, 281 (2d Cir. 1949) and cases cited therein. If a claim in a continuation-in-part application

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recites a feature which was not disclosed or adequately supported by a proper disclosure under 35 U.S.C. 112 in the parent nonprovisional application, but which was first introduced or adequately supported in the continuation-in-part application such a claim is entitled only to the filing date of the continuation-in-part application; In re Chu, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995); Transco Products, Inc. v. Performance Contracting Inc., 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994); In re Von Lagenhoven, 458 F.2d 132, 136, 173 USPQ 426, 429 (CCPA 1972); and Chromalloy American Corp. v. Alloy Surfaces Co., Inc., 339 F. Supp. 859, 874, 173 USPQ 295, 306 (D. Del. 1972). By way of further illustration, if the claims of a continuation-in-part application which are only entitled to the continuation-in-part filing date, "read on" such published, publicly used or sold, or patented subject matter (e.g., as in a genus- species relationship) a rejection under 35 U.S.C. 102 would be proper. Cases of interest in this regard are as follows: Mendenhall v. Cedarapids Inc., 5 F.3d 1557, 28 USPQ2d 1081 (Fed. Cir. 1993); In re Lukach, 442 F.2d 967, 169 USPQ 795 (CCPA 1971); In re Hafner, 410 F.2d 1403, 161 USPQ 783 (CCPA 1969); In re Ruscetta, 255 F.2d 687, 118 USPQ 101 (CCPA 1958); In re Steenbock, 83 F.2d 912, 30 USPQ 45 (CCPA 1936); Ex

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parte Hageman, 179 USPQ 747 (Bd. App. 1971). See also MPEP 201.11(a).

In view of the foregoing, the above claims have failed to patentably distinguish over the applied art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Kopec whose telephone number is (571) 272-1319. The examiner can normally be reached on Monday - Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Mark Kopec
Primary Examiner
Art Unit 1751

MK
July 13, 2004